

REMARKS

Claims 1-53 are currently pending, claims 24-53 being withdrawn, claims 1, 5, 8, 14 and 18 being amended.

Information Disclosure Statements

A supplemental Information Disclosure Statement is being submitted herewith that includes a concise explanation of the relevance of the "A marquer d'une pierre blanche" reference and the "Pregyplac Deco, la nouvelle plaque blanche" reference. Consideration of these references is respectfully requested.

Claim Amendments

Claim 1 was amended to recite a coating formulation for drywall application that comprises water, a binder present in an amount of between about 1.0% and about 4.0% by weight, a filler having a D50 between 5 and about 35 µm, said filler comprising at least about 60% by weight CaCO₃, and a polymeric noncellulosic thickener, wherein the coating formulation does not contain any cellulosic thickener and the viscosity of the coating formulation is from about 250 to about 1200 cps. Claim 14 has been amended to recite a coating formulation for drywall application that comprises: about 1 to about 4% by weight of a latex binder, about 40 to about 70% by weight of a filler having a D50 between 5 and about 35 µm and comprising at least about 60% by weight CaCO₃, about 0.5 to about 15% by weight of a dispersant, about 0.05 to about 50% by weight of a polymeric noncellulosic thickener, and water in an amount sufficient to provide a viscosity for the formulation of about 300 to about 450 cps, wherein the coating formulation does not contain any cellulosic thickener.

Claims 5, 8 and 18 have been amended to maintain consistency with claims 1 and 14.

Support for these amendment may be found throughout the application. For example, support for a binder being present in an amount of between about 1.0% and about 4.0% by weight may be found in paragraph [0023]. For example, support for a filler having a D50 between 5 and about 35 µm may be found in paragraph [0019]. For example, support for a polymeric noncellulosic thickener may be found in paragraph [0025]. For example, support for the coating formulation not containing

any cellulosic thickener may be found in paragraph [0025] and the Examples (see Tables 1 and 2), wherein the coating formulation does not contain any cellulosic thickener for either Example.

Double Patenting Rejection

Claims 1-4, 6-7 and 9-13 stand provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-4, 6-7 and 9-13 of copending Application No. 10/823,428.

Claims 5 and 8 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5 and 8 of copending Application No. 10/823,428.

Claims 14-23 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-23 of copending Application No. 10/823,428.

Applicants respectfully contend that the amendments to independent claims 1 and 14 of the present application render the double patenting rejections moot. Accordingly, withdrawal of the double patenting rejections is respectfully requested.

§102 Rejections

Claims 1, 2, 6, 7 and 11 stand rejected under 35 U.S.C. §102(b) as being anticipated by DE 4324315. Applicants respectfully traverse this rejection.

The presently claimed combination is a coating formulation for drywall application. There is a structural difference between a coating formulation for drywall application and a joint compound material. The composition in DE 4324315 is a joint compound, thus it is meant to be troweled, i.e. it exhibits a paste-like consistency, whereas the presently claimed composition is a coating formulation, i.e. it exhibits a fluid-like consistency.

DE 4324315 discloses a joint compound material based on an inorganic pigment, an organic film-forming binder composition and fibers. DE 4324315 does not teach or suggest the presently claimed combination. That is, DE 4324315 does not disclose a combination that includes a filler D₅₀ of about 5 to about 35 µm, or a viscosity of from about 250 to about 1200 cps.

Accordingly, applicants respectfully request withdrawal of the rejection based on DE 4324315.

Claims 1, 2, 6, 9 and 10 stand rejected under 35 U.S.C. §102(b) as being anticipated by Caldwell (USPN 5,869,166). Applicants respectfully traverse this rejection.

Caldwell discloses a coating formulation containing calcium carbonate, an acrylic emulsion thickener and an organic binder. The amount of organic binder is greater than 16 wt.% in all the illustrative formulations. The particle size of the solids is from 75 to 350 µm (see, e.g., claim 1). The viscosity is up to about 5000 cps and is 3000 cps in one example (see column 2).

Caldwell does not teach or suggest the presently claimed combination. That is, Caldwell does not disclose a combination that includes: a binder amount of about 1 to about 4 wt%; a filler D50 of about 5 to about 35 µm; or a viscosity of from about 250 to about 1200 cps.

Accordingly, applicants respectfully request withdrawal of the rejection based on Caldwell.

Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by Podlas (USPN 5,102,462). Applicants respectfully traverse this rejection.

The presently claimed combination is a coating formulation for drywall application. There is a structural difference between a coating formulation for drywall application and a joint compound material. The composition in Podlas is a joint compound, thus it is meant to be troweled, i.e. it exhibits a paste-like consistency, whereas the presently claimed composition is a coating formulation, i.e. it exhibits a fluid-like consistency.

Podlas discloses a joint compound based on limestone, a resinous binder and a thickener blend including a cellulosic part and a noncellulosic (polyacrylic) part. Podlas does not teach or suggest the presently claimed combination. That is, Podlas does not disclose a combination that includes: a filler D50 of about 5 to about 35 µm; a viscosity of from about 250 to about 1200 cps; or the absence of any cellulosic thickener.

Accordingly, applicants respectfully request withdrawal of the rejection based on Podlas.

Claims 1, 10 and 11 stand rejected under 35 U.S.C. §102(b) as being anticipated by Attard (USPN 5,336,318). Applicants respectfully traverse this rejection.

The presently claimed combination is a coating formulation for drywall application. There is a structural difference between a coating formulation for drywall application and a joint compound material. The composition in Attard is a joint compound, thus it is meant to be troweled, i.e. it exhibits a paste-like consistency, whereas the presently claimed composition is a coating formulation, i.e. it exhibits a fluid-like consistency.

Attard discloses a joint compound containing calcium carbonate, a binder (e.g. latex binder) and an *in situ* thickener such as an acidic acrylate copolymer. The *in situ* non-cellulosic thickener is used in combination with a cellulosic thickener (see, e.g., column 4, lines 11-13). The viscosity of the joint compound is 400-700 Brabender units (column 3, lines 59-62). The Examiner asserts that this range corresponds to 400-700 cps because Thaler (USPN 4,859,248) allegedly discloses that 1 Brabender unit is approximately 1 cps (item # 34 of the Office Action). However, the Applicant respectfully submits that this conversion is erroneous. See the attached Declaration of Jean Michel Faure. The Brabender method is used to measure the viscosity of pastes, not fluids. The composition used in Attard is a joint compound, thus it is meant to be troweled, i.e. it exhibits a paste-like consistency. As a result, the viscosity of the Attard composition of 400-700 Brabender units does not correspond to 400-700 cps.

Attard does not teach or suggest the presently claimed combination. That is, Attard does not disclose a combination that includes: a filler having a D50 of about 5 to about 35 μm ; a viscosity of from about 250 to about 1200 cps ; or the absence of any cellulosic thickener.

Accordingly, applicants respectfully request withdrawal of the rejection based on Attard.

Claims 1, 2, 6, 7, 9 and 11 stand rejected under 35 U.S.C. §102(b) as being anticipated by Lakshmanan (USPN 4,018,732). Applicants respectfully traverse this rejection.

Lakshmanan discloses an adhesive composition based on calcium carbonate, an emulsion polymer binder and a thickener selected from asbestos, treated clays, fumed silicas, i.e. a non-polymeric thickener. Lakshmanan does not teach or suggest the presently claimed combination. That is, Lakshmanan does not disclose a combination that includes: a binder amount of about 1 to about 4 wt%; a viscosity of from about 250 to about 1200 cps; or the presence of a polymeric non-cellulosic thickener.

Accordingly, applicants respectfully request withdrawal of the rejection based on Lakshmanan.

Claims 1, 2, 6, 7, 9 and 11 stand rejected under 35 U.S.C. §102(b) as being anticipated by Green (USPN 5,552,187). Applicants respectfully traverse this rejection.

Green discloses a coating composition comprising a limestone filler, a resin binder and clay as a thickener. The amount of resin is 15-35 wt% solids (see column 9, lines 41-45), which corresponds to an even greater resin component amount in the composition, namely more than 45 wt.% in all examples. The Brabender number of the composition is 50-100 (see column 9, lines 54-57) so that the composition is paste-like. For the same reasons already set forth above in relation with Attard, the Brabender measurement can only be used for paste-like compounds and the disclosed range is not equivalent to 300-550 cps. See the attached Declaration of Jean Michel Faure.

Green does not teach or suggest the presently claimed combination. That is, Green does not disclose a combination that includes: a binder amount of about 1 to about 4 wt%; a filler D₅₀ of about 5 to about 35 µm; a viscosity of from about 250 to about 1200 cps; or the presence of a polymeric non-cellulosic thickener.

Accordingly, applicants respectfully request withdrawal of the rejection based on Green.

Claims 1, 11 and 13 stand rejected under 35 U.S.C. §102(e) as being anticipated by Immordino (USPN 6,673,144). Applicants respectfully traverse this rejection.

The presently claimed combination is a coating formulation for drywall application. There is a structural difference between a coating formulation for drywall application and a joint compound material. The composition in Immordino is a joint compound, thus it is meant to be troweled, i.e. it exhibits a paste-like consistency, whereas the presently claimed composition is a coating formulation, i.e. it exhibits a fluid-like consistency.

Immordino discloses a joint compound comprising a filler, a binder and thickener. Only cellulosic thickeners are mentioned (see column 7, lines 52-57). The Brabender number of the composition is 300-550 (see column 8, lines 59-60). For the same reasons already set forth above in relation with Attard, the Brabender measurement can only be used for paste-like compounds and the disclosed range is not equivalent to 300-550 cps. See the attached Declaration of Jean Michel Faure.

Immordino does not teach or suggest the presently claimed combination. That is, Immordino does not disclose a combination that includes: a filler D50 of about 5 to about 35 µm; a viscosity of from about 250 to about 1200 cps; the presence of a polymeric non-cellulosic thickener; or the absence of any cellulosic thickener.

Accordingly, applicants respectfully request withdrawal of the rejection based on Immordino.

§103 Rejections

Claims 3-5, 8, 9 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 13427315 in view of Immordino (USPN 6,673,144), Brown (USPN 4,178,273) and Crawford (USPN 3,630,742). Applicants respectfully traverse this rejection.

Claims 3-5, 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Caldwell (USPN 5,,869,166) in view of Immordino (USPN 6,673,144). Applicants respectfully traverse this rejection.

Claims 2-4, 6 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Podlas (USPN 5,102,462) in view of Brown (USPN 4,178,273) and Crawford (USPN 3,630,742). Applicants respectfully traverse this rejection.

Claims 2-6, 9 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Attard (USPN 5,336,318) in view of Brown (USPN 4,178,273), Crawford (USPN 3,630,742) and Immordino (USPN 6,673,144). Applicants respectfully traverse this rejection.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Attard (USPN 5,336,318) in view of Deodhar (USPN 6,663,979). Applicants respectfully traverse this rejection.

Claims 3-5, 8 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lakshmanan (USPN 4,018,732) in view of Immordino (USPN 6,673,144). Applicants respectfully traverse this rejection.

Claims 3, 4 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Green (USPN 5,552,187) in view of Immordino (USPN 6,673,144). Applicants respectfully traverse this rejection.

Claims 2-9 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Immordino (USPN 6,673,144) in view of Brown (USPN 4,178,273) and Crawford (USPN 3,630,742). Applicants respectfully traverse this rejection.

Claims 14, 17, 18, 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Attard (USPN 5,336,318) in view of Brown (USPN 4,178,273) and Crawford (USPN 3,630,742). Applicants respectfully traverse this rejection.

Claims 15, 16 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Attard (USPN 5,336,318) in view of Brown (USPN 4,178,273) and Crawford (USPN 3,630,742) and further in view of Immordino (USPN 6,673,144). Applicants respectfully traverse this rejection.

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Attard (USPN 5,336,318) in view of Brown (USPN 4,178,273) and Crawford (USPN 3,630,742) and further in view of Deodhar (USPN 6,663,979). Applicants respectfully traverse this rejection.

Claims 14-19 and 21-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Immordino (USPN 6,673,144) in view of Brown (USPN 4,178,273) and Crawford (USPN 3,630,742). Applicants respectfully traverse this rejection.

In view the claim amendments to independent claims 1 and 14 and the remarks presented above with regard to the anticipation rejections, applicants respectfully assert that all present claims are non-obvious over the prior art of record. The prior art of record does not disclose a combination that includes the characteristic of the viscosity being from about 250 to about 1200 cps. Accordingly, there is no combination of the above documents that may render the presently claimed invention obvious.

Among the abovementioned documents, Lakshmanan pertains to an adhesive composition, whereas Caldwell and Green pertain to coating compositions, and Podlas, Attard, DE 4324315 and Immordino pertain to joint compound compositions. Adhesive compositions, coating compositions and joint compound compositions are very different products having very different physicochemical properties. Therefore, one skilled in the art would have no reason or motivation to combine the teachings of these three groups of documents together.

Moreover, one skilled in the art would not have consulted Podlas, Attard, DE 4324315 or Immordino because all these documents relate to joint compounds, i.e. paste-like compositions having a very high viscosity and meant to be troweled, whereas the present invention aims at providing a fluid-type composition useful for online coating.

Further, one skilled in the art would not have consulted Lakshmanan, because an adhesive composition has totally different characteristics and purposes (namely bonding substrates together, see column 3, lines 53-58) than a coating formulation, so that there would have been no reason or motivation for one skilled in the art to rely on the teaching of Lakshmanan.

Consequently, the characteristics i), of the binder amount being of about 1 to about 4 wt%, and ii), of the filler D50 being of about 5 to about 35 µm, could not have been properly obtained by a mere combination of the cited art.

Turning now to Caldwell and Green, it should also be emphasized that both documents teach including a very high amount of binder in their respective compositions (see above). Now, using such high amounts of binder in a composition

applied on a facer before the dryer would result in orange peel (i.e. the appearance of numerous small bumps and indentations). Therefore, the compositions of Caldwell and Green would have been totally inappropriate for the purposes of the present invention so that one skilled in the art would not have had nor reason to use the teaching of either of these documents.

More specifically, the Caldwell composition is intended to be used on soft mineral fiber panels. Therefore, one skilled in the art would understand that this composition aims at providing sound absorbing acoustical properties and at combating the dusty aspect of the panels. The thick structure of the composition (with large filler particles) is required for such goals, and, in turn, the large binder amount is necessary in order to be able to glue together the large filler particles. In contrast, the present invention aims at obtaining a fine finish (see paragraph 19), which, as the present inventors have found, may be obtained *via* smaller particles and less binder. In other words, Caldwell teaches away from the present invention.

For similar reasons Green also teaches away from the present invention if only because of the considerably high amount of binder (more than 45 wt.%) which is on the one hand necessary to impart the water-resistance sought by Green, and on the other hand utterly incompatible with the present invention.

As a final remark, the present inventors have found that cellulosic thickeners are an impediment for obtaining a level 5 finish. As a result, Podlas, Attard and Immordino all teach away from the present invention if only because they teach to include a cellulosic thickener in their respective compositions.

In view of the above, claims 1 and 14 are non-obvious in view of the cited prior art. The same applies *mutatis mutandis* to the other claims, so that the rejections under 35 USC §103 have reasonable basis.

Conclusion

Accordingly, in view of the foregoing amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw all of the objections and rejections.

In the event that there are any questions concerning this amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

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